

## **REMARKS/ARGUMENTS**

### **1.) Claim Amendments**

The Applicant has amended claims 1, 3, 6, 7, and 9. Claims 2 and 4 have been canceled. Applicant respectfully submits no new matter has been added. Accordingly, claims 1, 3, 6, 7, and 9-13 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

### **2.) Claim Rejections – 35 U.S.C. § 102(e)**

The Examiner rejected claims 1, 6, and 12 under 35 U.S.C. § 102(e) as being anticipated by Li et al. (US Patent No. 6,591,301). The Applicant has amended the claims to better distinguish the claimed invention from Li. The Examiner's consideration of the amended claims is respectfully requested.

The Examiner stated that Li discloses a method for controlling the processing of messages by a packet-based network gatekeeper in order to prevent the gatekeeper's processor from crashing, wherein messages relating to calls in progress are handled preferentially relative to messages relating to new calls.

In regards to claims 1 and 6, the Examiner stated that Li discloses that if the frequency of messages associated with new calls exceeds a certain threshold, "in-progress message favoring" may be invoked. The Examiner also stated that Li discloses that the message type is determined by examining the message header and if the call is associated with a new call, then the message is discarded.

In response, the Applicant has amended claim 1 to incorporate the limitations of claims 2 and 4, and has amended claim 6 to incorporate the limitations of claim 8. Amended claims 1 and 6 recite that the method is carried out by a serving general packet radio service support node (SGSN) after the SGSN is re-started or by a base station system (BSS) after the BSS is re-started.

Li does not disclose that the method is conducted by an SGSN after the SGSN is re-started or by a BSS after the BSS is re-started. Therefore, the allowance of amended claims 1 and 6 is respectfully requested.

Claim 12 depends from amended claim 6 and recites further limitations in combination with the novel elements of claim 6. Therefore, the allowance of claim 12 is respectfully requested.

**3.) Claim Rejections – 35 U.S.C. § 103 (a)**

**Claims 2, 7, and 9-10**

In the Office Action, the Examiner rejected claims 2, 7, and 9-10 under 35 U.S.C. 103(a) as being unpatentable over Li in view of Haumont et al. (U.S. Patent No. 6,233,458). However, Haumont merely discloses that a SGSN may need to be shut down after a malfunction or due to a high level of traffic. The Applicant acknowledges that SGSNs may be shutdown at various times and Haumont does disclose this. However, Haumont merely discloses this shutdown in the context of a re-routing procedure which changes a key network element in a connection without interrupting the traffic. Haumont does not teach or suggest providing any type of overload protection in packet communication networks after re-starts of an SGSN or re-starts of a BSS. Both Li and Haumont discuss different solutions to different problems from each other and from the Applicant's invention.

It is important to recognize that “[w]hen an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references.” *WMS Gaming Inc. v. International Game Technology*, 51 USPQ 2d 1385, 1397 (Fed. Cir. 1999). See also *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1456 (Fed. Cir. 1999); *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

As reiterated and emphasized by the Federal Circuit, such a requirement is a powerful protection against impermissible hindsight reconstruction:

“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

[citations omitted]. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight...[citations omitted]." *In re Dembiczak*, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999).

In this case, Li discloses a method for controlling network gatekeeper message processing. Quite distinctly, Haumont discloses a re-routing processing by modifying key network elements. There is no motivation for combining these references describing two different and entirely distinct areas of network technology. Therefore, the Applicant respectfully submits that the combination of Li and Haumont is improper since a claimed invention can "not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention." *National Steel Car Ltd. v. Canadian Pacific Railway Ltd.*, 69 USPQ 2d 1641, 1654-55 (Fed. Cir. 2004), citing *Ecologchem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ 2d 1065, (Fed. Cir. 2000). Indeed, the only teaching or suggestion that supports the combination of these references is found in the teaching of the present application. In short, this is a classic case of hindsight reconstruction in which the present patent application has been used as "a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983).

The limitations of claims 2 and 4 have been incorporated into claim 1. Claim 2 has been canceled. Claims 7, 9, and 10 are dependent upon amended independent claim 6. Claim 6 includes the limitation that the method is carried out by a SGSN after the SGSN is re-started or by a BSS after the BSS is re-started. Haumont merely discloses the shutdown of an SGSN, but provides no motivation to combine with Li. Therefore, the allowance of claims 7, 9, and 10 is respectfully requested.

### **Claim 3**

The Examiner rejected claim 3 under 35 U.S.C. 103(a) as being unpatentable over Li in view of Maruyama et al. (U.S. Patent No. 6,430,272). The Examiner stated

that Maruyama discloses a procedure for processing messages according to a user's wishes at a message processing apparatus in a communication system. The Applicant has amended the independent base claim from which claim 3 depends to better distinguish the claimed invention from Li and Maruyama. The Examiner's consideration of the amended claim is respectfully requested.

Claim 3 depends from independent claim 1 and recites further limitations in combination with the novel and unobvious elements of claim 1. As discussed above, claim 1 has been amended to recite a method which is carried out by a SGSN after the SGSN is re-started or by a BSS after the BSS is re-started. The combination of Li and Maruyama does not teach or suggest a method which is carried out by a SGSN after the SGSN is re-started or by a BSS after the BSS is re-started. Thus, the Applicant respectfully requests the withdrawal of the §103 rejection and the allowance of claim 3.

#### **Claims 4 and 8**

The Examiner rejected claims 4 and 8 as being unpatentable over Li in view of Ekman. Claims 4 and 8 have been canceled.

#### **Claims 11 and 13**

The Examiner rejected claims 11 and 13 under 35 U.S.C. 103(a) as being unpatentable over Li in view of En-Seung et al. (U.S. Patent No. 6,892,306). The Applicant has amended the independent base claim from which claims 11 and 13 depend to better distinguish the claimed invention from Li and En-Seung. The Examiner's consideration of the amended claim is respectfully requested.

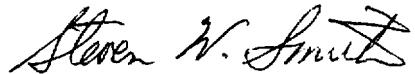
Claims 11 and 13 depend from independent claim 6 and recite further limitations in combination with the novel and unobvious elements of claim 6. Claim 6 has been amended to recite a method which is carried out by a SGSN after the SGSN is re-started or by a BSS after the BSS is re-started. As discussed above, the combination of Li with Haumont or Ekman is improper because there is no motivation to combine the two references. The addition of En-Seung does not make up for the missing elements of Li. Thus, the Applicant respectfully requests the withdrawal of the §103 rejection and the allowance of claims 11 and 13.

**CONCLUSION**

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1, 3, 6, 7, and 9-13.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

  
By Steven W. Smith  
Registration No. 36,684

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Ericsson Inc.  
6300 Legacy Drive, M/S EVR 1-C-11  
Plano, Texas 75024

(972) 583-1572  
steve.xl.smith@ericsson.com